

## **REMARKS**

### ***Changes to Claims***

Claims 1, 3-7, 29, 55, and 57-60 have been amended. Claims 2, 8-13, 17-19, 21-22, 26-27, 40-49, 52, 56, and 61 are herein cancelled, without conceding the patentability of that subject matter, as new claims 66-72 have been added to more distinctly claim the invention encompassed therein.

### ***Claim rejections - 35 U.S.C. § 103***

The Examiner maintained the obviousness rejection under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 5,897,626 to Bratby-Carey, in view of U.S. Patent No. 2,663,891 to Hanryon and U.S. Patent No. 6,276,856 to Pieper. The Examiner's continued rejection of the claims over Bratby-Carey, in view of Hanyron and Pieper, is respectfully traversed.

First, the Examiner stated that "while the applicant is arguing the importance of the surface roughness of the roller ball with respect to the viscosity of the dispensing product, nowhere in the original specification actually discloses *the criticality* of such relationship." The substance of the relationship was clearly disclosed within the specification at ¶ 4 of the published application 2004/0234321 A1 (stating "The surface of the roller ball be smooth or slightly roughened depending on the consistency of the product to be dispensed..."), which is all that is required of Applicant. There is no requirement to specifically denote critical aspects of any invention, whereas, conversely, Applicant's are required to disclose the invention in its entirety.

As stated by the Examiner, the condition for patentability with regard to non-obviousness

is found in 35 U.S.C. § 103 which states that:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time...”

This requirement of disclosing the entire invention is also emphasized in MPEP 2141.02 “Differences Between Prior Art and Claimed Invention,” in stating that “ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole.”

Moreover, the fact that statements of criticality are not required is shown by the opinion of the Court of Appeals for the Federal Circuit, which has spoken to this principle in the case of *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1546, 220 USPQ 303, 309 (Fed. Cir. 1983), in stating:

Each claimed invention must be considered as a whole. 35 U.S.C. Sec. 103; *Schenck, A.G. v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698, 700 (Fed.Cir.1983). In determining obviousness, there is "no legally recognizable or protected 'essential', 'gist', or 'heart' of the invention".

In fact, MPEP 2141.02(II) now cites the *Garlock* case, with the manual furthermore stating that:

Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole...”

The only requirement as to the specificity of the disclosure is its compliance with 35 U.S.C. § 112, first paragraph, in that it must provide “a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains,..., to make and use the same.” The Applicant has satisfied this requirement in disclosing the significance of the surface roughness of

the roller ball in relation to the consistency/viscosity of the cosmetic substance sought to be dispensed.

Next, the Examiner stated that the added claim language concerning surface roughness ("said first roller ball having a surface roughness calibrated for optimal delivery of said product, said surface roughness of said first roller ball being selected to be within a range of a smooth to a slightly rough surface roughness depending upon said product's viscosity") was well within the skill of an artisan at the time the invention was made.

Although the Applicant has herein amended independent claim number 55 to more distinctly claim the invention and better comport with the advantageous nature of the dual cosmetics container disclosed within the specification, the Examiner's assertion contravenes the requirements of MPEP 2143.01(IV), which states:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art **is not sufficient to establish a *prima facie* case of obviousness** without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

Even the U.S. Supreme Court has addressed the issue, in the recent case of *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385, 1396 (2006), by quoting from the Federal Circuit case of *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), as follows:

Rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

These court decisions reflect the fact that there are well over 300,000 patented inventions within the USPTO database in which “viscosity” is at least a consideration, if not a significant factor, in achieving the particular combination defining the advantageous nature of, or means of producing, those particular inventions (see e.g., U.S. Patent No. 3,930,921 for “Method of Finishing Leather,” and 5,788,734 for “Method for Drawing Glass Preform for Optical Fiber”). With regard to “surface roughness,” the USPTO database contains over 39,000 patented inventions similarly concerned.

The Applicant would seek to argue that a combination proffered by the Examiner may teach away from the invention herein, or that such a combination may constitute impermissible hindsight in accordance with *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) (“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself...”), but no such combination was proffered. In fact, the Applicant even argued on page 17, line 14 of the last amendment that the advantageous use of the surface roughness of the roller balls in relation to product viscosity in such cosmetic dispensing devices was nowhere in the cited prior art (“Therefore, the fact that none of the prior art references even considered the viscosity of the product in relation to the means being utilized for dispensing...”).

Lastly, the Examiner also rejected the above noted claim limitation regarding viscosity and surface roughness based upon the case of *In re Aller*, 220 F.2d 454, 105 USPQ 233, 235 (CCPA 1955) (“Where the general conditions of a claim are disclosed in the prior art, it is not

inventive to discover the optimum or workable ranges by routine experimentation...). However, use in this instance of the *Aller* case is inapt.

In the case of *In re Aller*, the general conditions were already established and were, in fact, very close. In *Aller*, the claimed process was performed at temperatures between 40°C and 80°C and sulfuric acid concentrations between 25% and 70%, and was held to be *prima facie* obvious in view of a prior art reference process with claimed differences only in that the prior art process was performed at a temperature of 100°C and a sulfuric acid concentration of 10%.

*Aller*, 105 USPQ at 234. MPEP 2144.05(I) states that:

“...a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties.”

Here, there is no prior art reference even disclosing similar applicability of surface roughness calibrated according to product viscosity for proper dispensing of cosmetic substances, and certainly not as to the structural combination that strategically permits two dissimilarly viscous cosmetic substances from being properly dispensed from a dual cosmetics product dispenser.

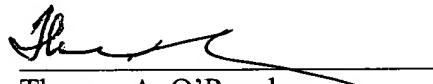
Therefore, based upon the above discussion, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 103(a), as to independent claim 55. Claim 66 is also patentably distinguishable over the prior art for analogous reasons, as it is drawn to a dual cosmetic device comprising one roller ball having its surface roughness similarly tailored to the viscosity of a first cosmetic product, and to a doe foot applicator for application of a second cosmetic product. Claim 1 is similarly patentable but includes a brush applicator instead of the doe foot applicator.

As claims 3-7 and 29 depend from allowable claim 1, claims 57-60 depend from allowable independent claim 55, and claims 67-72 depend from allowable claim 66, Applicant further submits that dependent claims 3-7, 29, 57-60, and 67-72 are allowable for at least this reason.

***CONCLUSION***

In view of the foregoing amendments and remarks, favorable consideration of the claims and allowance of the application are respectfully solicited.

Respectfully submitted,

  
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